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SERIAL NUMBER	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
08/[illegible]	[illegible]	[illegible] BOUCHARD	M 12907201

EXAMINER
PEABODY, S

12MC/0123

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WASHINGTON, D.C. 20004

ART UNIT	PAPER NUMBER
1206	#18

DATE MAILED: 01/23/95

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

☒ This application has been examined ☒ Responsive to communication filed on 12-29-94 ☐ This action is made final.

A shortened statutory period for response to this action is set to expire Ø month(s), 30 days from the date of this letter.
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

1. ☐ Notice of References Cited by Examiner, PTO-892.
2. ☐ Notice re Patent Drawing, PTO-948.
3. ☐ Notice of Art Cited by Applicant, PTO-1449.
4. ☐ Notice of Informal Patent Application, Form PTO-152.
5. ☐ Information on How to Effect Drawing Changes, PTO-1474.
6. ☐ _____

Part II SUMMARY OF ACTION

1. ☒ Claims 1-5, 13, 24, 30-54, 62, 73, 79-139 are pending in the application.

   Of the above, claims _____ are withdrawn from consideration.

2. ☐ Claims _____ have been cancelled.
3. ☐ Claims _____ are allowed.
4. ☐ Claims _____ are rejected.
5. ☐ Claims _____ are objected to.
6. ☒ Claims 1-5, 13, 24, 30-54, 62, 73, 79-139 are subject to restriction or election requirement.
7. ☐ This application has been filed with informal drawings under 37 C.F.R. 1.85 which are acceptable for examination purposes.
8. ☐ Formal drawings are required in response to this Office action.
9. ☐ The corrected or substitute drawings have been received on _____. Under 37 C.F.R. 1.84 these drawings are ☐ acceptable. ☐ not acceptable (see explanation or Notice re Patent Drawing, PTO-948).
10. ☐ The proposed additional or substitute sheet(s) of drawings, filed on _____ has (have) been ☐ approved by the examiner. ☐ disapproved by the examiner (see explanation).
11. ☐ The proposed drawing correction, filed on _____, has been ☐ approved. ☐ disapproved (see explanation).
12. ☐ Acknowledgment is made of the claim for priority under U.S.C. 119. The certified copy has ☐ been received ☐ not been received ☐ been filed in parent application, serial no. _____; filed on _____
13. ☐ Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.
14. ☐ Other

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EXAMINER'S ACTION

PTOL-326 (Rev. 9-89)

Applicants amendment of 12-29-94 crossed in the mail with the supplemental restriction requirement of 12-30-94 (paper #15). Because applicants amendments introduce new claims, all prior restriction requirements are hereby withdrawn by the examiner and upon further consideration the following new restriction requirement is made.

Restriction to one of the following inventions is required under 35 U.S.C. § 121:

I. Claims 1-4, 30-53, 79-97, 98-102, drawn to compounds compositions and method of use, classified in Class/subclass 514/449 and 549/510.

II. Claims 5, 54, 115-139, drawn to methods of making, classified in Class 549, subclass 510.

III. Claims 13 and 62, drawn to method of making, classified in Class 549, subclass 510.

IV. Claims 24 and 73, drawn to method of making, classified in Class 549, subclass 510.

V. Claim 103, drawn to compounds, classified in Class 549, subclass 510.

VI. Claims 104-106, drawn to method of making, classified in Class 549, subclass 510.

VII. Claims 107-111, drawn to compounds, classified in Class 548, subclass 100+.

VIII. Claims 112-114, drawn to method of making, classified in Class 549, subclass 510.

Claims 1, 103, and 107 are generic to a plurality of disclosed patentably distinct species comprising those defined by the working examples. Applicants elected species should define an compound, composition and method of use which is ultimately disclosed in the specification. Applicant is required under 35 U.S.C. § 121 to elect a single disclosed species, even though this requirement is traversed.

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. § 103 of the other invention.

The inventions are distinct, each from the other because of the following reasons:

The inventions of Groups I, V and VII drawn to compounds which are composed of chemically diverse functionalities which have not disclosed relationship and thus are independent and distinct. The compounds would be expected to have different physical properties and pharmacological activity and therefore materially different utilities. The inventions as claimed are capable of separate manufacture, use and sale. The inventions as claimed are capable of supporting separate patents, and a

reference used to obviate one could not be used against the other.

The inventions of Groups II-IV, VI and VIII drawn to methods of making are composed of chemical process which use materially different reaction condition and/or use materially reagents and/or product materially different products, and/or involve materially different intermediates, and which have not disclosed relationship and thus are independent and distinct. The inventions as claimed are capable of separate manufacture, use and sale. The inventions as claimed are capable of supporting separate patents, and a reference used to obviate one could not be used against the other.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, have acquired a separate status in the art because of their recognized divergent subject matter and the search required for Group VII is not required for any other Group, restriction for examination purposes as indicated is proper.

Applicant is advised that the response to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in

compliance with 37 C.F.R. § 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a diligently-filed petition under 37 C.F.R. § 1.48(b) and by the fee required under 37 C.F.R. § 1.17(h).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John D. Peabody III, Ph.D. whose telephone number is (703) 308-4690.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-1235.

J.D.P. III

January 23, 1995

JOHANN RICHTER
SUPERVISORY PATENT EXAMINER
GROUP 1200